REMARKS

As a preliminary matter, it is respectfully submitted that the enclosed amendment does not raise any new issues that would require further consideration and/or search, and is not relied upon for differentiating the present invention over the cited prior art. Accordingly, it is respectfully requested that the amendment be entered and considered to place the application in better form for a possible appeal.

Claims 1-8, 10-12, 14 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Machida '060 ("Machida"). Claims 1, 2, 8, 14 and 15 are independent. This rejection is respectfully traversed for the following reasons.

Each of claims 1, 2 and 8 embody an update program which starts running *in response* to turning on a power source of the disk system. The Examiner has maintained the pending rejection based on the allegation that, in one respect, "updating [in Machida] must occur after the power is turned on [, and in a second respect,] the updating occurs after a physical disk has failed and been replaced [thereby illustrating] that the updating program is the first operation that occurs after the power is on." As a preliminary matter, the Examiner's assertion that updating "must" occur after the power is turned on is incorrect. Machida performs the updating only if a disk device has failed in order to update the replacement disk device. Accordingly, if no disk devices fail, there would be no updating.

Moreover, the Examiner's assumption that "updating" is the first operation after turning on the power is also incorrect, in that the Examiner assumes that there is a failed disk device. Machida does not suggest that there will be a failed disk device each time the

power is turned on. Accordingly, the updating process may not occur at all much less be the first operation after the power is turned on. In fact, Machida expressly discloses the notion that updating can occur during operation (*see* col. 10, lines 27-31), thereby evidencing that updating can occur after the power has been turned on for a long period of time and after many unrelated operations.

Further, even if there is a failed device, Machida is concerned only with the updating process for the firmware of the new disk device so that only the operation thereof is discussed. It is quite possible that the updating process occurs after other unrelated operations which are inherent but not expressly described by Machida. As is well known in patent prosecution, "inherency may not be established by probabilities or possibilities," *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999).

Nonetheless, regardless of whether the updating process is the first operation after the power is turned on or not, the updating process of Machida is not performed "in response to" the power being turned on. The Examiner appears to believe that being the first operation after turning on the power necessitates that the updating process is "in response to" turning on the power. This is incorrect. It appears that the Examiner has interpreted the claim limitation "in response to turning on a power source" as merely requiring updating to occur "after turning on a power source." It is respectfully submitted that the Examiner's broad interpretation is unreasonable.

According to the Examiner's interpretation, any operation/function occurring after turning on the power in Machida could be construed as being in response to turning on the power. However, as is well known, the term "in response to" requires some causal link, more than just happenstance, between turning on the power and starting the update

program. The plain meaning of "response" is "something constituting a reaction." *Merriam-Webster's Collegiate Dictionary*, Tenth Edition, at 995 (2000). Simply because the updating in Machida occurs after the power is turned on does not mean that commencement of the updating process is a reaction to the power being turned on. Rather, turning on the power merely places the system in Machida in a standby mode whereby updating *can* occur *if there is a failed disk device which is replaced*.

In contrast, according to an aspect of the present invention, updating firmware of the lower disk devices occurs in response to turning on a power source of the disk system, regardless of whether there is a failed disk device or not; whereas in Machida, a disk device must first fail and a replacement introduced before updating occurs. The updating in Machida is therefore performed in response to the replacement of the failed disk device rather than to turning on the power. Indeed, if none of the disk devices failed, there would be no updating in Machida so that the power would be turned on yet no updating would take place (possibly leaving some disk devices with lower firmware versions).

To best illustrate the improper interpretation of "in response to", the following example is provided: in a dark room a light switch is turned on; the lights in the room illuminate light in response to the turning on of the switch (i.e., in reaction to the switch being turned on); with light in the room, someone in the room can read a book. In this example, reading the book is NOT in response to the switch being turned on but rather is enabled thereby. Similarly, in Machida, turning on the power simply enables the updating process to take place if needed, but the updating process is not performed as a reaction to (i.e., in response to) the power being turn on.

In summary, turning on the power in Machida *enables* updating to occur by providing the necessary resources (e.g., power) to perform the updating process, so as to "set the stage" *if* the updating process is deemed necessary. However, the updating process is ultimately performed only in response to a failed disk device and subsequent introduction of a new disk device. In this regard, Machida is concerned only with ensuring that the *replacement* for a failed disk device has updated firmware, rather than all of the disk devices having the latest firmware as can be performed in the present invention.

Indeed, with respect to claims 14 and 15, it appears the Examiner has misunderstood Applicants' previously filed arguments. That is, Applicants did not argue that updating is not inherent in Machida. It is not disputed that Machida discloses an updating process. However, Machida does not disclose or suggest updating the firmware of *each* of the plurality of disk devices to the latest version. Instead, the device of Machida merely updates the firmware *if* there is a replacement disk device introduced, and then would only update the *replacement disk device*. In this regard, if the replacement disk device of Machida itself has the latest version of firmware, NO updating takes place (*see* col. 10, lines 14-26 of Machida); whereas in the present invention, the firmware of the "new disk device" would be used to update the other lower version "reference" disk device(s) to the latest firmware. As recited in claim 14 (similarly in claim 15), the "computer determines the latest version of firmware from the firmware of the plurality of disk devices and updates the firmware of *each* of said plurality of disk devices to said latest version" (emphasis added).

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Machida does not anticipate claims 1, 2, 8, 14 and 15, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 2 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination. Based on all the foregoing, it is respectfully submitted that claims 1-8 and 10-12, 14 and 15 are patentable over Machida. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 102 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

09/673,628

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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